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| APPLICATION NO.      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|------------------|
| 10/018,332           | 12/13/2001  | Jorg Hofmann         | Mo-6843/LeA 33,555  | 7899             |
| 157                  | 7590        | 05/14/2004           | EXAMINER            |                  |
| BAYER POLYMERS LLC   |             |                      | COONEY, JOHN M      |                  |
| 100 BAYER ROAD       |             |                      | ART UNIT            | PAPER NUMBER     |
| PITTSBURGH, PA 15205 |             |                      | 1711                |                  |

DATE MAILED: 05/14/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 0504

Application Number: 10/018,332

Filing Date: December 13, 2001

Appellant(s): HOFMANN ET AL.

Lyndanne M. Whalen  
For Appellant

**EXAMINER'S ANSWER**

*MAILED  
MAY 14 2004  
GROUP 1700*

This is in response to the appeal brief filed April 8, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 11 and 13-15 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

Art Unit: 1711

**(9) Prior Art of Record**

|           |                  |         |
|-----------|------------------|---------|
| 6,008,263 | THOMPSON et al.  | 12-1999 |
| 6,066,683 | BEISNER et al.   | 5-2000  |
| 5,648,559 | HAGER            | 7-1997  |
| 5,668,191 | KINKELAAR et al. | 9-1997  |

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 11 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Thompson et al.(6,008,263).

Thompson et al.(6,008,263) discloses preparations of flexible polyurethane foams prepared from isocyanates and polyether polyols prepared in the presence of double metal cyanide catalyst and having molecular weights encompassing of those claimed by appellants (see columns 5,6, 7 and 8 in their entirety and the examples, as well as, the entire document). Thompson et al.'s disclosure is encompassing of the distributions and amounts of the various blocks in the polyols used as described by appellants' claims, and no distinction is seen to exist between the reference's disclosed flexible foams and the foams defined by appellants' claimed foaming techniques as they are both directed towards flexible foams and it is the composition which defines the product being claimed in the instant case.

Claims 11 and 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Beisner et al.(6,066,683).

Beisner et al. discloses preparations of flexible polyurethane foams prepared from isocyanates and polyether polyols prepared in the presence of double metal cyanide catalyst and having molecular weights encompassing of those claimed by appellants (see column 5 line 50 – column 10 line 2, and the examples, as well as the entire document). Beisner et al.'s disclosure is encompassing of the distributions and amounts of the various blocks in the polyols used as described by appellants' claims, and no distinction is seen to exist between the reference's disclosed flexible foams and

the foams defined by appellants' claimed foaming techniques as they are both directed towards flexible foams and it is the composition which defines the product being claimed in the instant case.

Claims 11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hager (5,648,559).

Hager discloses preparations of flexible polyurethane foams prepared from isocyanates and polyether polyols prepared in the presence of double metal cyanide catalyst and having molecular weights encompassing of those claimed by appellants (see column 5 line 17 – column 8 line 17, and the examples, as well as, the entire document). Hager's disclosure is encompassing of the distributions and amounts of the various blocks in the polyols used as described by appellants' claims, and no distinction is seen to exist between the reference's disclosed flexible foams and the foams defined by appellants' claimed foaming techniques as they are both directed towards flexible foams and it is the composition which defines the product being claimed in the instant case.

Claims 11 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinkelaar et al.(5,668,191)

Kinkelaar et al. discloses preparations of flexible polyurethane foams prepared from isocyanates and polyether polyols prepared in the presence of double metal cyanide catalyst and having molecular weights encompassing of those claimed by

appellants (see column 4 line 14 – column 5 line 25, and the examples, as well as, the entire document). Kinkelaar et al.'s disclosure is encompassing of the distributions and amounts of the various blocks in the polyols used as described by appellants' claims, and no distinction is seen to exist between the reference's disclosed flexible foams and the foams defined by appellants' claimed foaming techniques as they are both directed towards flexible foams and it is the composition which defines the product being claimed in the instant case.

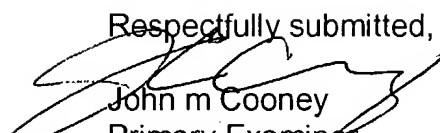
**(11) Response to Argument**

Applicants' arguments have been considered. However, rejections are maintained for the reasons set forth above.

All of appellants' arguments rest on the premise that the claim limitation defining their polyols as having "a terminal propylene oxide block" limits the claims to being absent of any ethylene oxide in the terminal groups (see appellants' arguments particularly at page 5 of the Appeal Brief). To this examiner reiterates his comments made in the Advisory Action dated 3-3-04, that appellants' claims do not define their "type" of terminal propylene oxide block in the claims in a manner which distinguishes the claims over Thompson et al., the evidence from the examples are not reflected in the claims in a manner which distinguishes the claims over the Beisner et al., the differences discussed in regard to Hager are not supported by the limitations of the claims, and applicants' terminal propylene oxide block is not defined to distinguish over

the Kinkelaar et al. reference. Examiner holds and maintains that the evidence indicated by page and column, the examples, and the documents in their entirety as stated in the rejections above supports his position that the claim limitation "having a terminal propylene oxide block" does not limit the claim to being fully capped by propylene oxide blocks but rather merely requires the presence of at least a single "terminal propylene oxide block". The evidence of record does not distinguish the polyols included within appellants' claims to be read as being exclusive of random blocks or any of the partially propylene oxide block capped polyols of the cited patents. While examiner reiterates that it is the entirety of the evidence cited in the rejections above that supports his position of anticipation, column 7 of the cited Beisner et al. patent (6,066,683) highlights the evidence in the art that partial capping of the polyols of the instant concern reads on the claim limitation "having a terminal propylene oxide block" rather than the meaning alleged by appellants in their arguments.

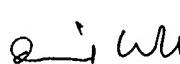
For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,  
  
John m Cooney  
Primary Examiner  
Art Unit 1711

JMC  
May 11, 2004

Conferees

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